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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|--|
| Proceeding | 92062786 |
| Party | Plaintiff Hudson Shoe Agencies Limited |
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| Submission | Other Motions/Papers |
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| Signature | /Michele P. Schwartz/ |
| Date | 12/10/2015 |
| Attachments | Letter to Andrew Vanderford.pdf(345482 bytes) |

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December 7, 2015

Via U.S. Certified Mail

Mr. Andrew Vanderford
1835 E. Willie Court
Columbia City, Indiana 46725

Re: Trademark Registration No. 4547771
Mark: PURIFLYED

Dear Mr. Vanderford:

I am writing on behalf of our client, Hudson Shoe Agencies Limited (“Hudson”), regarding your registration for the mark PURIFLYED, U.S. Registration No. 4547771. I initially contacted Mr. James Hudak, who is listed as your attorney with the United States Patent and Trademark Office, and was informed that he no longer represents you. **If you are represented by counsel, please immediately forward this communication to counsel.**

Hudson recently submitted a trademark application for the mark PURIFIED & Bird Design for shoes, shoe accessories and clothing, Serial No. 79134254. A copy of the mark with the bird design is depicted as follows:



PURIFIED

The trademark registration has not yet been granted because the Examining Attorney at the Trademark Office believes there is a likelihood of confusion between Hudson’s PURIFIED & Bird Design mark and goods, and your PURIFLYED mark and goods.

As reflected in the attached Petition for Cancellation that was filed with the Trademark Trial and Appeal Board (“TTAB”) on December 7, 2015, Hudson began shipping goods bearing the PURIFIED & Bird Design mark to the United States on or about August 31, 2012. Your registration indicates that your first use in commerce of the mark PURIFLYED was March 5, 2014. Therefore, Hudson has superior common law rights to its PURIFIED & Bird Design mark

Mr. Andrew Vanderford
December 7, 2015
Page 2

than you have in your PURIFLYED mark. Furthermore, it appears that you have not used your mark for all the goods listed in your registration, including jeans, jackets, coats, belts, and shoes.

While Hudson is fully prepared to litigate these issues with you at the TTAB through the Cancellation proceeding, we believe it may be in the best interest of both parties to avoid the time and expense of doing so by entering into a coexistence and consent agreement. Through the agreement, you and Hudson would each acknowledge the differences between the marks as they are now used and consent to the other's use and registration of the respective marks. We would withdraw the Cancellation proceeding as part of the agreement.

If you are agreeable to such terms, please let me know and I will send you a draft agreement for execution. If not, we will continue with the Cancellation proceeding

Sincerely,

/Michele P. Schwartz/

MPS:tdw

Encls.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

| | | |
|------------------------------|---|------------------------------|
| HUDSON SHOE AGENCIES LIMITED |) | |
| |) | |
| Petitioner, |) | |
| |) | Cancellation No. _____ |
| v. |) | |
| |) | (Registration No. 4,547,771) |
| |) | |
| ANDREW VANDERFORD, |) | |
| |) | |
| Registrant. |) | |

ORIGINAL PETITION FOR CANCELLATION

Hudson Shoe Agencies Limited (“Hudson” or “Petitioner”) believes it is, and will continue to be, damaged by the maintenance of Registration No. 4,547,771 on the Principal Register, and hereby petitions to cancel same. As grounds for cancellation, Petitioner alleges as follows:

1. Upon information and belief, Andrew Vanderford (“Registrant” or “Mr. Vanderford”) is an individual residing at 1835 E. Willie Court, Columbia City, Indiana 46725. Registrant can be served through his attorney of record, James Hudak, at 29425 Chagrin Boulevard, Suite 304, Cleveland, Ohio 44122.

2. Hudson is a Limited Company organized under the laws of the United Kingdom with a place of business at 20 Hoxton Square, London N1 6NT, United Kingdom. Established in 1990, Hudson is an international retailer of contemporary, classic, and original shoes for men and women.

3. Hudson owns Application Serial No. 79/134254 for the mark PURIFIED & Design as depicted below for the following goods:

“Footwear; Footwear, namely, men's footwear, women's footwear, children's footwear, casual footwear, formal footwear, athletic footwear, climbing footwear,

waterproof footwear, water repelling footwear, footwear uppers, shoes, athletic shoes, canvas shoes, deck shoes, dress shoes, sports shoes, tennis shoes, golf shoes, waterproof shoes, water repelling shoes, shoe uppers, stiffeners for shoes in the nature of shoe inserts for non-orthopedic purposes, athletic shoes in the nature of trainers, sneakers, slippers, sandals, moccasins, plimsolls, pumps, boots, ankle boots, half-boots, lace boots, hiking boots, wellington boots, waterproof boots, water repelling boots, boot uppers, stiffeners for boots in the nature of boot inserts for non-orthopedic purposes, soles, embossed soles of rubber or plastic material, insoles, inner soles, outer soles, heels, stiletto heels, embossed heels of rubber or plastic material, heel inserts, tips for footwear, toe caps; clothing, namely, shirts, tops, t-shirts, sweaters, blouses, sweatshirts, pants, trousers, slacks, shorts, jeans, coats, jackets, blazers, vests, hosiery, sweatpants, suits, bow ties, neckties, capes, swim wear, dresses, skirts, gowns, pajamas, lingerie, sleepwear, belts, gloves, scarves, hats, caps, parts therefor for all the aforesaid goods; headwear, in International Class 25.



PURIFIED

4. Hudson has made continuous use of the mark PURIFIED & Design for footwear in United States commerce since August 31, 2012.

5. Hudson filed Application Serial No. 79/134254 on July 11, 2013. Hudson's application was rejected based on Registration No. 4,547,771 owned by Registrant for the mark PURIFLYED, the Examining Attorney finding that there is a likelihood of confusion between Hudson's mark and Registrant's mark.

6. On January 29, 2013, Registrant filed Application Serial No. 76/713321 for the mark PURIFLYED—on an intent-to-use basis—in connection with “articles of wearing apparel, namely, hats, shirts, jeans, jackets, coats, belts and shoes,” in International Class 25. On March

12, 2014, Registrant filed a declaration with the United States Patent and Trademark Office (“USPTO”) relating to his PURIFLYED application, claiming a date of first use in commerce of March 5, 2014,

7. Even assuming, *arguendo*, the veracity of the statements set forth in Registrant’s application and declaration, both the filing date of Registrant’s application (i.e., Registrant’s constructive first-use date) and alleged date of first use in commerce for Registrant’s mark PURIFLYED are well after Hudson began using the mark PURIFIED & Design for its goods.

Likelihood of Confusion

8. Mr. Vanderford’s mark PURIFLYED for the goods listed above is likely to cause confusion with Hudson’s mark PURIFIED & Design for its goods in the minds of the purchasing public. In particular, the appearance, sound, and commercial impression of Registrant’s mark PURIFLYED are nearly identical to that of Hudson’s mark PURIFIED. Furthermore, Registrant’s goods are identical to Hudson’s goods in that they both consist of shoes and wearing apparel. Given the similarities of the marks and goods, there is a likelihood of confusion between Hudson’s mark PURIFIED & Design and Mr. Vanderford’s mark PURIFLYED.

9. Based on the foregoing, Mr. Vanderford’s registration is causing and will continue to cause injury and damage to Hudson unless and until such registration is cancelled.

WHEREFORE, respectfully requests the Registration No. 4,547,771 be cancelled and that this petition for cancellation be sustained.

Date: December 7, 2015

By: /s/ Michele P. Schwartz
ANDREWS KURTH LLP
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Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 7th day of December, 2015, a true copy of the foregoing "Original Petition for Cancellation" was served by first-class mail, postage pre-paid on the attorneys for Registrant at the following address:

James A. Hudak
29425 Chagrin Boulevard, Suite 304
Cleveland, Ohio 44122-4637
james_hudak@att.net

/s/ Crystal L. Jamison
Crystal L. Jamison